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Paper No. 6

Zion Hadad
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COPY MAILED

MAR 10 2004

In re Application of :
Zion Hadad :
Application No. 09/493,662 :
Filed: January 28, 2000 :
Attorney Docket No. :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 17, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the non-final Office action mailed March 13, 2003, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on June 14, 2003. A Notice of Abandonment was mailed on November 18, 2003.

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks items (1) and (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”³

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled; if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁴

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁵

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.”⁶

The standard

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”⁷

³*Rydeen v. Quigg*, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing *Morganroth v. Quigg*, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); *Ethicon, Inc. v. Quigg* 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also *Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc.*, 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”))

⁴*Commissariat A L’Energie Atomique et al. v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵*Haines v. Quigg*, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing *Camp v. Pitts*, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); *Beerly v. Dept. of Treasury*, 768 F.2d 942, 945 (7th Cir. 1985); *Smith v. Mossinghoff*, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁶*Ray v. Lehman*, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing *Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁷Id.

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸ Nonawareness of a PTO rule will not constitute unavoidable delay.⁹

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that the non-final Office action mailed March 13, 2003, was not received.

With regard to item (1) above, a petition under 37 CFR 1.137 cannot be granted until a proper response to the Office action is received. In this case, a proper response would consist of an amendment or a continuing application. A proper response must accompany any renewed petition under 37 CFR 1.137(b).

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reasons petitioner's argument must necessarily fail are addressed below.

When, as in this case petitioner is arguing that an Office communication was not received, petitioner must establish non-receipt of the Office communication in accordance with section 711.03(c) of the *Manual of Patent Examining Procedure* that requires the following:

[t]he showing requires to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received/ A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

In this case, where petitioner is a pro se applicant, petitioner may satisfy these requirements by offering a statement that petitioner records were searched, but the Office communication was not found and providing a copy of petitioner's logs showing where the Office communication

⁸See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

⁹See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

would have been entered if it had been received. A renewed petition under 37 CFR 1.137(a) should provide all the requested evidentiary documents.

Petitioner has also failed to requirements of item (3) above because a successful petition under 37 CFR 1.137(a) requires that petitioner establish that the entire delay in filing the required reply—from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a)—was unavoidable. Petitioner did not account for the eight month delay in filing the instant petition—the relevant period being from the due date for the reply of June 13, 2003, until the filing of the instant petition on February 17, 2004. The petition under 37 CFR 1.137(a) will not be considered grantable until the entire period of delay is determined to be unavoidable.

Petitioner may wish to consider filing a petition to withdraw the holding of abandonment pursuant to 37 CFR 1.181 on the grounds of petitioner's alleged non-receipt of the Notice. Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b) (enclosed). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee (\$1,330.00 for a large entity and \$665.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

A copy of the non-final Office action is also enclosed for petitioner convenience.

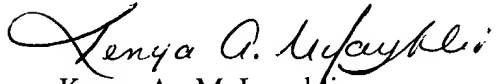
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clarke Place
Crystal Plaza 4, Suite 3C23
Arlington, Virginia 22202

Telephone inquiries should be directed to the undersigned (703) 305-0010.



Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Form PTO/SB/64

Copy—Non-Final Office action mailed March 13, 2003
